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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,148	03/06/2002	Kumiko Naito	122.1496	5920

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EXAMINER
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CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/091,148

Applicant(s)

NAITO, KUMIKO

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on December 12, 2006, in which claims 1-4, 11-14 and 16 are presented for further examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-4, 11-14 and 16 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4, 11-14 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While outputting a result indicative thereof and searching menu information from the menu storage means, including said ingredient when the result indicates that said amount of said ingredient is less than said sale unit, as recited in claims 1-4 could be reasonably be considered a tangible and useful result. The claim appears to have no claimed result in the condition when the amount of said ingredient is greater than said sale unit. Based on the analysis provided therein, the claim fails to form the basis statutory subject matter under 35 U.S.C 101.

While outputting data of an ingredient, a sale unit and an amount of the ingredient upon a menu search, where the amount of the ingredient indicated by the menu search is searched for

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using remaining amounts of previously used ingredients of each menu corresponding to the indicated sale unit and an indication is provided when the ingredient indicated is less than the sale unit and the sale unit of each ingredient is associated with the menu information including the previously used ingredients of each menu, as recited in claim 13 could be reasonably be considered a tangible and useful result. The claim appears to have no claimed result in the condition when the ingredient indicated is greater than said sale unit. Based on the analysis provided therein, the claim fails to form the basis statutory subject matter under 35 U.S.C 101.

Claim 14 recites a method claim for automatically searching ingredient information of each of the menu items including remaining previously used ingredient of the second menu responsive to a search request with respect to the first menu item and indicating when the ingredient constituting the first menu item is less than an amount of the previously used ingredient constituting the second menu item. Claim 14 appears to produce no tangible, concrete and useful under both condition when the ingredient constituting the first menu item is less and greater than an amount of the previously used ingredient constituting the second menu item to form the basis statutory subject matter under 35 U.S.C 101.

While providing said obtained ingredients for the new menu to the user upon determination that amounts of ingredients necessary for the new menu are less than remaining amounts of the previous menu, as recited in claim 16 could be reasonably be considered a tangible and useful result. The claim appears to have no claimed result in the condition when the new menu is greater than the remaining amounts of the previous menu. Based on the analysis provided therein, the claim fails to form the basis statutory subject matter under 35 U.S.C 101.

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Therefore, claims 1-4, 11-14 and 16 are directed to an abstract idea, which fails to produce a concrete, tangible and useful result to form the basis statutory subject matter under 35 U.S.C 101.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the claimed feature of ***“comparing means for automatically comparing the amount of said ingredient searched out by the ingredient amount searching means with remaining amounts of the previously used ingredients of the other menus corresponding to the sale unit searched by the sale unit searching means and outputting a result indicative thereof”*** is not described in the specification to enable one having ordinary skill in the art to make and use the invention. The specification paragraph [0072] and [0073] compares the expected sales for every ingredient computed with the "the amount of the stock" in the stock-for-network-sale DB corresponding the predetermined merchandise. However, such cited portion of the specification does not include the use of ***“comparing means for automatically comparing the amount of said ingredient searched out by the ingredient amount***

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*searching means with remaining amounts of the previously used ingredients of the other menus corresponding to the sale unit searched by the sale unit searching means and outputting a result indicative thereof”.*

The examiner finds that the cited portion of the Applicant disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application. Based on the analysis provided above and substantial evidence or reasoning, the examiner provided that one having ordinary skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. The amended claims, which introduce elements or limitations “automatically comparing is not supported by the as-filed disclosure, which is violated the written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Applicant should duly note that the first paragraph of 35 U.S.C. 112 requires that the “specification shall contain a written description of the invention. Applicant should also note that the essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed; and to put the public in possession of what the applicant claims as the invention.” Furthermore, the written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Indeed, the specification does not satisfy the written description requirement because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 10-13 as best understood by the examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase et al., (hereinafter "Iwase") US Patent Application Publication no. 2002/0165803 and Chinfen US Patent no. 4,233,018.

As to claims 1, 2, 3 and 4, Iwase discloses the claimed "means for receiving the menu information input through member terminals" for receiving a request from a user requesting information on a predetermined disk (requesting information on a predetermined dish or menu, see page 2, paragraph [0013], lines 5-7); "menu storage means for storing the menu information and amounts of ingredients necessary to prepare each menu indicated in the menu information" (storing a plurality of disk names and names of the ingredients necessary for making each disk and recipe for each dish, see page 2, paragraph [0013], lines 13-16); "ingredient amount searching means for searching out the ingredients and the amounts thereof, from the menu storage means, corresponding to said menu information" (total number ingredients, see page 2, paragraph [0017], lines 18-27); "sale unit storage means for storing a sale unit for every ingredient, the sale unit of each ingredient being stored in association with the stored menu information" (storing the names of the ingredient in the ingredient table, by having stored the

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ingredient in the ingredient table, the previously used ingredient is also stored in the table for later use (col.6, paragraph [0105] and [0107]). In addition, Iwase discloses the claimed “sale unit searching means for searching out the sale unit, from the sale unit storage means, corresponding to said ingredient searched out by the ingredient amount searching means” searching the ingredient information database for a dish maker having necessary ingredient (page 2, paragraph [0017], lines 22-29); “comparing means for automatically comparing the amount of said ingredient searched out by the ingredient amount searching means with amounts of ingredients corresponding to the sale unit searched by the sale unit searching means and outputting a result indicative thereof” (comparing one or more ingredient information, see page 2, paragraph [0013], lines 21-28); and “menu information searching means for searching out the menu information, from the menu storage means, including said ingredient in case that the result indicates that said amount of said ingredient is less than said sale unit” (page 6, paragraph [0111], [0112] and page 8, paragraph [0139]). However, Iwase does not explicitly disclose the use of remaining amounts of previously used ingredients of other menu. On the other hand, Chinfen discloses analogous system that provides a maximum ingredient needed to prepare an egg roll (col.1, lines 19-21). Chinfen states that the egg roll can also be prepared using a wide variety of additional ingredients, which are available in a restaurant as left over ingredients from other intended dishes (remaining amounts of previously used ingredients) (col.1, lines 23-25). Chinfen discloses the use of remaining amounts of previously used ingredients of other menu (col.1, lines 23-25). These teachings of Chinfen (col.1, lines 19-21 and 23-25) clearly provides evidence that remaining amounts of previously used ingredients of other menus to create other or new menu, similarly to the description provided by the specification paragraph 10, 16, 19 and 20.



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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the recipes of dishes as disclosed by Iwase (see fig.27) would incorporate the use of gathering remaining amounts of previously used ingredients of other menus, in the same conventional manner as disclosed by Chinfen (col.1, lines 23-25). One having ordinary skill in the art would have found it motivated to use such a remaining amounts of previously used ingredients of other menus for the purpose of creating a new or other dishes.

As to claims 10, 11 and 12, Iwase discloses the claimed “means for transmitting ingredients of a first menu and a number of distributions of the first menu to a user terminal”[0149]-0152]; and “a means for transmitting ingredients of a second menu inquired in relation to the first menu and a number of the inquiries of the second menu to the user terminal” [0149]-0152].

As to claim 13, Iwase discloses the claimed “storing menu information and amounts of ingredients necessary to prepare each menu indicated in the menu information and storing a sale unit for each ingredient of each menu” (col.6, paragraph [0105] and [0107]; page 2, paragraph [0017], lines 22-29); and “outputting data of an ingredient, a sale unit and an amount of the ingredient upon a menu search, where the amount of the ingredient indicated as a result of the menu search is searched corresponding to the indicated sale unit and an indication is provided when the ingredient indicated is less than the sale unit, the sale unit of each ingredient being stored in association with the stored menu information” (page 2, paragraph [0013], lines 21-28; page 6, paragraph [0111], [0112] and page 8, paragraph [0139]). However, Iwase does not

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explicitly disclose the use of remaining amounts of previously used ingredients of other menu. On the other hand, Chinfen discloses analogous system that provides a maximum ingredient needed to prepare an egg roll (col.1, lines 19-21). Chinfen states that the egg roll can also be prepared using a wide variety of additional ingredients, which are available in a restaurant as left over ingredients from other intended dishes (remaining amounts of previously used ingredients) (col.1, lines 23-25). Chinfen discloses the use of remaining amounts of previously used ingredients of other menu (col.1, lines 23-25). These teachings of Chinfen (col.1, lines 19-21 and 23-25) clearly provides evidence that remaining amounts of previously used ingredients of other menus to create other or new menu, similarly to the description provided by the specification paragraph 10, 16, 19 and 20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the recipes of dishes as disclosed by Iwase (see fig.27) would incorporate the use of gathering remaining amounts of previously used ingredients of other menus, in the same conventional manner as disclosed by Chinfen (col.1, lines 23-25). One having ordinary skill in the art would have found it motivated to use such a remaining amounts of previously used ingredients of other menus for the purpose of creating a new or other dishes.

As to claim 14, Iwase discloses the claimed “associating an ingredient constituting a first menu item among the menu items with a second menu item among the menu items” (page 8, paragraph [0134] and [0135]); and “automatically searching ingredient information of each of the menu items responsive to a search request with respect to the first menu item and indicating when the ingredient constituting the first menu item is less than an amount ingredient constituting the

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second menu item” (page 8, paragraph [0139]). However, Iwase does not explicitly disclose the use of remaining amounts of previously used ingredients of other menu. On the other hand, Chinfen discloses analogous system that provides a maximum ingredient needed to prepare an egg roll (col.1, lines 19-21). Chinfen states that the egg roll can also be prepared using a wide variety of additional ingredients, which are available in a restaurant as left over ingredients from other intended dishes (remaining amounts of previously used ingredients) (col.1, lines 23-25). Chinfen discloses the use of remaining amounts of previously used ingredients of other menu (col.1, lines 23-25). These teachings of Chinfen (col.1, lines 19-21 and 23-25) clearly provides evidence that remaining amounts of previously used ingredients of other menus to create other or new menu, similarly to the description provided by the specification paragraph 10, 16, 19 and 20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the recipes of dishes as disclosed by Iwase (see fig.27) would incorporate the use of gathering remaining amounts of previously used ingredients of other menus, in the same conventional manner as disclosed by Chinfen (col.1, lines 23-25). One having ordinary skill in the art would have found it motivated to use such a remaining amounts of previously used ingredients of other menus for the purpose of creating a new or other dishes.

As to claim 16, Iwase discloses the claimed “receiving the menu information from a user” for receiving a request from a user requesting information on a predetermined disk (requesting information on a predetermined dish or menu, see page 2, paragraph [0013], lines 5-7); “searching for ingredients necessary for the new menu” (substituting ingredients, see page 2,

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paragraph [0017], lines 18-27 and page 8, [0139]); and “providing said obtained ingredients for the new menu to the user upon determination that amounts of ingredients necessary for the new menu” (page 6, paragraph [0111], [0112] and page 8, paragraph [0139]). However, Iwase does not explicitly disclose the use of remaining amounts of previously used ingredients of other menu. On the other hand, Chinfen discloses analogous system that provides a maximum ingredient needed to prepare an egg roll (col.1, lines 19-21). Chinfen states that the egg roll can also be prepared using a wide variety of additional ingredients, which are available in a restaurant as left over ingredients from other intended dishes (remaining amounts of previously used ingredients) (col.1, lines 23-25). Chinfen discloses the use of remaining amounts of previously used ingredients of other menu (col.1, lines 23-25). These teachings of Chinfen (col.1, lines 19-21 and 23-25) clearly provides evidence that remaining amounts of previously used ingredients of other menus to create other or new menu, similarly to the description provided by the specification paragraph 10, 16, 19 and 20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the recipes of dishes as disclosed by Iwase (see fig.27) would incorporate the use of gathering remaining amounts of previously used ingredients of other menus, in the same conventional manner as disclosed by Chinfen (col.1, lines 23-25). One having ordinary skill in the art would have found it motivated to use such a remaining amounts of previously used ingredients of other menus for the purpose of creating a new or other dishes.

*Remark*

9. Applicant asserted that paragraphs 10, 16, 19, 20, 21, 23, 26, 28, 29, fig.2-4, 11D and 12A support the use of automatically comparing the amount of said ingredient searched out by the ingredient amount searching means with remaining amounts of the previously used ingredients of the other menus corresponding to the sale unit searched by the sale unit searching means and outputting a result indicative thereof. However, the portion of the specification cited by the applicant has nothing to do with the use of automatically comparing. The system discloses in the instant application relies on a user input to perform a certain task. Paragraph 10, for example, "the ingredient information managing apparatus is a computer having a processor and a memory, and is placed in, such as, an ingredient information managing center where the information such as ingredients of dishes, etc. is managed. This information may be accessed from both of the member terminals and the shop terminals. The apparatus has five databases (DBs) including a distribution date DB whose components will be described later, a menu DB 120, a member DB 130, a shop DB 140, and a sale unit DB 150, and a program for inquiring to obtain menus using remaining ingredients from the previous menu, which receives the distribution date of the last cooking information from a member, and searches for, while referring each of the above DBs, the information about new dishes using the ingredients presumed to remain when preparing the last dish. As one can see there is nothing the specification refers to automatic comparing.

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*Conclusion*


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032.

The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jean M. Corrielus  
Primary Examiner  
Art Unit 2162

February 23, 2007